

REMARKS

Claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22 and 24 are currently pending in the application.

This amendment is in response to the final Office Action of May 19, 2008.

35 U.S.C. § 112 Claim Rejections

Claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22 and 24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have amended the claimed invention to delete the use of the word “type” for the presently claimed invention to particularly point out and distinctly claim the subject matter of the invention to comply with the provisions of 35 U.S.C. § 112. Therefore, presently amended claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22 and 24 are allowable under the provisions of 35 U.S.C. § 112.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Weng et al. (U.S. Patent 5,972,234)

Claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Weng et al. (U.S. Patent 5,972,234). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of

obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Turning to the cited prior art, Weng et al. teaches or suggests a method for marking a semiconductor surface. Weng et al. describe a polymeric tape can be provided that is suitable for ablative photodecomposition. Column 4 lines 25-40. In other words, the mark which is to be formed in the semiconductor surface is first formed as a cavity through the tape using "high-intensity energy beams such as ultraviolet light or laser." Column 4 lines 32-33; *See also* column 2 lines 63-63, column 3 lines 6-11, column 3 lines 22-23, column 3 lines 27-30, column 3 lines 39-40, column 4 lines 52-54. After the mark has been formed *through* the tape, the tape is applied to the semiconductor surface. Column 4 line 57 – column 5 line 7. Finally, the mark is formed in the semiconductor surface by etching the semiconductor in the area exposed by the mark formed in the tape. The tape protects the rest of the semiconductor surface from the etchant, such that the mark in the tape is patterned into the semiconductor surface. Column 5 lines 8-25. Finally, the tape is removed from the surface of the semiconductor, leaving the mark formed by the etchant. Column 5 lines 27 – 37. The tape has a thickness of about 0.5 mm and can be provided with an adhesive backing or without an adhesive backing. Column 5, lines 38-41. A suitable adhesive may be an acrylic type polymer. Column 4, lines 63,64. Weng et al. does not teach or suggest forming a mark on a semiconductor surface using an ultraviolet light or laser to cause adhesive of the tape to cure and bond to the semiconductor surface forming a mark thereon as only an etching process forms a mark on the semiconductor surface.

The Ishiwata et al. reference teaches or suggests the use of a single layer radiation curable adhesive tape on a wafer to form a three dimensional network.

Applicants assert that any combination of the Weng et al. reference in view of the Ishiwata et al. reference fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed inventions of presently amended independent claims 1, 9, and 17 because cited prior art fails to teach or suggest all the claim limitations and the suggestion to make the claimed combination and the reasonable expectation of success is found solely in Applicants' disclosure, not the cited prior art.

Applicants assert that any combination of the cited prior art does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed inventions of independent claims 1, 9, and 17 because any such combination of the cited prior art fails to teach or suggest all the claim limitations of the claimed inventions.

Applicants assert that any combination of the cited prior art fails to teach or suggest the claim limitations of the presently amended independent claims 1, 6, and 17 calling for “a multilayer adhesive used solely for laser marking a semiconductor device including: a first outermost adhesive layer comprising a mixture of electromagnetic radiation-curable components that upon exposure to an electromagnetic radiation source cure and bond to at least a portion of a semiconductor device and form a mark on the semiconductor device by the electromagnetic radiation- curable components curing, bonding and remaining on the semiconductor device when a laser marks a semiconductor device; and a second adhesive layer separate and distinct from the first outermost adhesive layer, the second adhesive layer disposed between the tape and the first outermost adhesive layer, the second adhesive layer comprising a mixture of electromagnetic radiation-curable components that upon exposing to radiation the second adhesive layer facilitate peeling of a flexible film material by a reduction in adhesiveness of the second adhesive layer with respect to the first outermost adhesive layer when the electromagnetic radiation from a laser strikes the second adhesive layer during laser marking a semiconductor device”, “a marking tape having a coefficient of thermal expansion substantially similar to the semiconductor device; and a multilayer adhesive used solely for laser marking a semiconductor device including: a first outermost adhesive layer comprising a mixture of electromagnetic radiation-curable components

having a first outermost adhesive layer providing a mark on a laser-markable surface upon exposure thereof to electromagnetic radiation by curing and bonding to at least a portion of a semiconductor device by the electromagnetic radiation- curable components curing, bonding, and remaining on the semiconductor device when a laser marks a semiconductor device; and a second adhesive layer separate and distinct from the first outermost adhesive layer, the second adhesive layer disposed between the flexible film material and the first outermost adhesive layer, the second adhesive layer a mixture of electromagnetic radiation-curable components that upon exposing to radiation the second adhesive layer facilitate peeling of a flexible film material by a reduction in adhesiveness of the second adhesive layer when laser marking a semiconductor device”, and “at least two layers of adhesive used solely for laser marking a semiconductor device including: a first outermost adhesive layer comprising a mixture of electromagnetic radiation-curable components providing a mark on a surface upon exposure thereof to electromagnetic radiation by curing and bonding to at least a portion of a semiconductor device, the radiation-curable components forming the mark by curing and bonding to a surface of the semiconductor device when a laser marks a semiconductor device; and a second adhesive layer separate and distinct from the first outermost adhesive layer, the second adhesive layer disposed between the film material and the first outermost adhesive layer, the second adhesive layer having second properties comprising a mixture of electromagnetic radiation-curable components that upon exposing to radiation the second adhesive layer solely facilitate peeling of a flexible film material by a reduction in adhesiveness of the second adhesive layer when laser marking a semiconductor device by the electromagnetic radiation from the laser striking the second adhesive layer”.

Applicants assert that the first adhesive layer and the second adhesive layer as claimed clearly comply with the requirements of 35 U.S.C. § 112, second paragraph, as the characteristics and function thereof are clearly set forth in the claims.

Further, Applicants assert that since the cited prior art fails to teach or suggest the claim limitations of the claimed inventions of independent claims 1, 9, and 17 and since there has been no showing that one of ordinary skill in the art based on the cited prior art would consider the claim limitations to be obvious based on any teachings of any prior

art, the rejection of claimed 1, 3, 4, 6, 8, 9, 1,, 12, 14, 16, 17, 19, 20, 22, and 24 based on any combination of the Weng et al. reference in view of the Ishiwata et al. reference is a hindsight reconstruction of the claimed inventions base solely upon Applicants' disclosure which is *impermissible*. Applicants note that the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Applicants assert that there has been no such showing. Additionally, underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367. **Again, Applicants assert that all and any hindsight is prohibited and cannot be used regarding any rejection under 35 U.S.C. § 103 as the *KSR* decision clearly overrules the earlier *In re McLaughlin* case.** Applicants note that nowhere has there been any showing that the *In re McLaughlin* case is appropriate law permitting the use of any hindsight in any rejection under 35 U.S.C. § 103 after the *KSR* decision which Applicants assert overrules the *In re McLaughlin* case. No authority has been cited that a 1971 CCPA case is the controlling case law authority over a 2007 United States Supreme Court decision which states that all and any hindsight is prohibited and cannot be used regarding a rejection under 35 U.S.C. § 103.

Applicants assert that there has been no showing of success for any combination of the Weng et al. reference in view of the Ishiwata et al. reference whatsoever. Applicants further assert that there is no reason set forth to modify the Weng et al. reference in view of the Ishiwata et al. reference, other than Applicants disclosure. Applicants further assert that since neither the Weng et al. reference nor the Ishiwata et al. reference nor any combination of the Weng et al. reference in view of the Ishiwata et al. reference teaches or suggests all the claim limitations of independent claims 1, 9, and 17, such claims are rejected based solely on hindsight based solely on Applicants disclosure which is *impermissible*.

Applicants request entry of this amendment for the following reasons:

The amendment is timely filed.

The amendment does not require any further search or consideration.

Therefore, claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22, and 24 are allowable.

Applicants request the entry of this amendment, the allowance of claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22, and 24 and the case passed for issue.

Respectfully submitted,



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